

REMARKS

Claims 1-8 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,319,338 (hereinafter referred to as "the '338 patent") to Kowano et al (misidentified in the Action as Koyama et al.). Applicant respectfully disagrees.

Claim 1 recites the following limitations:

quenching, following said step of annealing, said steel alloy at a temperature to transform at least a portion of said austenite into martensite;
carbon partitioning, following said step of annealing, said steel alloy to transfer carbon from said martensite to said austenite;

Kowano, et al. do not teach or otherwise disclose "quenching and partitioning" as claimed by the applicant. To be sure, Kowano, et al. makes no distinction between quenched martensite and "partitioned martensite", as claimed. Rather, Kowano, et al. teaches that bainite is the preferred means of creating the retained austenite. The use of bainite teaches around the focus of the claimed invention. For example, Kowano, et al. discloses the quench temperature to be within one hundred degrees of the martensite, whereas the claimed process, and the supporting examples from the specification, teach greater variances between the quenching temperature and the martensite.

Anticipation under 35 U.S.C. § 102 focuses on the questions of whether or not a claim reads on the product or process disclosed by a prior art reference, not what the reference broadly "teaches." Kalman v. Kimberly-Clarke Corp., 713 F.2d 760 (Fed. Cir. 1983). "For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed function must be identically shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675 (Fed. Cir. 1988); Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference). The differences between the Kowano, et al. methodology and that claimed within claim 1 are substantial and significant. Kowano, et al. teaches none of the relevant aspects of the quenching and partitioning process, such as the claimed austenite stabilization by carbon that was present in martensite. The transfer and use of carbon from the martensite to stabilize the

austenite is not disclosed or otherwise suggested by the reference; whatsoever. Accordingly, claim 1 is believed to be allowable over Kowano, et al.

Each of claims 2-8 is a dependent claim that depends either directly or indirectly from independent claim 1. Consequently, each of these dependent claims is at least allowable for the reasons noted with respect to independent claim 1. However, each of these dependent claims may be allowable for additional reasons, and the applicant reserves the right to assert any such reason in the future.

A petition for a three month extension of time under 37 CFR §1.136(a) and the requisite fees is submitted herewith. If any additional extension or fee is required but not otherwise submitted herewith, please consider this a request for any such extension and authorization to debit Deposit Account 08-2623 for any such additional required fee.

The application now appearing to be in form for allowance, reconsideration and allowance thereof is respectfully requested. If a telephone conversation will further the prosecution and/or expedite allowance, the examiner is invited to contact the undersigned attorney.

Respectfully submitted,

HOLLAND & HART LLP

By: 

Shane M. Niebergall, Esq.

Registration No. 44,794

P.O. Box 8749

Denver, Colorado 80201-8749

(303) 295-8034

Date: 21 JAN 08